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REMARKS

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No amendments have been made in the preceding section.

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Applicant respectfully requests further examination and reconsideration of claims 1-6, still pending in the application.

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The last Office Action, dated March 15, 2002, has been carefully considered, and it is noted that:

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a) Claims 3, 5, and 6 are rejected under 35 U.S.C. 102(a) as being anticipated by Brendel et al.;

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b) Claim 2 is rejected under 35 U.S.C. 102(e) as being anticipated by Bell et al.; and

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c) Claims 1 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brendel et al. in view of Bell et al.

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In response to the Examiner's rejection of claims 3, 5, and 6 under 35 U.S.C. 102(a) as being anticipated by Brendel et al., the Examiner's rejection of claim 2 under 35 U.S.C. 102(e) as being anticipated by Bell et al., and the Examiner's rejection of claims 1 and 4 under 35 U.S.C. 103(a) as being unpatentable over Brendel et al. in view of Bell et al., applicant respectfully draws the Examiner's attention to the fact that the Federal Circuit holds that relevant case law must be relied upon in determining obviousness ipso facto the determination of obviousness is a matter of law, as was decided in In re Deuel, 51 F.3d 1552, 1557, 34 USPQ.2d (BNA) 1210, 1214 (Fed. Cir. 1995), where the Court held:

"Obviousness is a question of law, which we review de novo,

1 though factual findings
2 underlying the Board's
3 o b v i o u s n e s s
4 determination are
5 reviewed for clear
6 error. In re Vaeck,
7 947 F.2d 488, 493, 20
8 USPQ2d 1438, 1442 (Fed.
9 Cir. 1991); In re
10 Woodruff, 919 F.2d 1575,
11 1577, 16 USPQ2d 1934,
12 1935 (Fed. Cir. 1990)."
13 [at 1214][Emphasis
14 added]

15 And, in Richardson-Vicks Inc. v. The Upjohn Co., 122 F.3d 1476, 44
16 USPQ.2d 1181 (Fed. Cir. 1997), where the Court held:

17 "The difficulty with
18 RVI's position is that,
19 although the argument
20 has merit when the issue
21 is purely one of fact,
22 it does not follow when
23 the issue involves a
24 question of law. It is
25 black letter law that
26 the ultimate question of
27 obviousness is a
28 question of law. "See
29 Graham v. Deere Co., 383
30 U.S. 1, 17, 148 USPQ
31 459, 467 (1966) (citing
32 Great A. & P. Tea Co. v.
33 Supermarket Equip. Co.,
34 340 U.S. 147, 155, 87
35 USPQ 303, 309 (1950));
36 In re Donaldson Co., 16
37 F.3d 1189, 1192, 29
38 USPQ2d 1845, 1848 (Fed.
39 Cir. 1994) (en banc);
40 Texas Instruments Inc.
41 v. Unit States Int'l
42 Trade Comm'n, 988 F.2d
43 1165, 1178, 26 USPQ2d
44 1018, 1028 (Fed. Cir.

1 1993). And we review
2 that legal question
3 without deference to the
4 trial court. See
5 Gardner V. TEC Sys.
6 Inc., 725 F.2d 1338,
7 1344, 220 USPQ 777, 782
8 (Fed. Cir. 1984)
9 (district court's
10 conclusion on
11 obviousness "is one of
12 law and subject to full
13 and independent review
14 in this court"). "[at
15 1183][Emphasis added]

16 In the seminal case of Graham v. John Deere Co., 383 U.S. 1, 17, 148
17 USPQ 459, 467, 15 L.Ed. 2d 545, 86 S. Ct. 684 (1966), the Supreme Court
18 articulated the requirements for a prima facie holding of obviousness.
19 The Patent Office has since set forth in MPEP 706.02 a three step
20 requirement for establishing a prima facie case of obviousness.

21 The first step requires that the Examiner must set forth the
22 differences in the claim over the applied references. The second step
23 requires that the Examiner must set forth the proposed modification of the
24 reference which would be necessary to arrive at the claimed subject
25 matter. And, the third step requires that the Examiner must explain why
26 the proposed modification would be obvious.

27 The Courts require that in order to satisfy the third step for
28 establishing a prima facie case of obviousness, the Examiner must identify
29 where the prior art provides a motivating suggestion to make the
30 modifications proposed in the second step for establishing a prima facie
31 case of obviousness, as was expressed in the 1992 Federal Circuit Court
32 decision in In re Jones, 958, F.2d 347, 21 USPQ.2d 1941, where the Court
33 held:

34 "Contention that one
35 skilled in the
36 herbicidal art would

1 have been motivated to
2 use, with acid commonly
3 known as "dicamba,"
4 substituted ammonium
5 salt such as that
6 disclosed in two prior
7 references does not
8 warrant holding that
9 claimed substituted
10 ammonium salt of dicamba
11 for use as herbicide is
12 prima facie obvious,
13 since there is no
14 suggestion for combining
15 disclosures of those
16 references either in
17 references themselves,
18 which are directed to
19 shampoo additives and
20 production of
21 morpholine,
22 respectively, or in
23 knowledge generally
24 available to those
25 skilled in the art."[at
26 1941][Emphasis added]

27 "The Solicitor points
28 out that, given the
29 breadth of forms of
30 dicamba (free acid,
31 ester, or salt)
32 disclosed by Richter as
33 having herbicidal
34 utility, one of ordinary
35 skill in the art would
36 appreciate that the
37 dicamba group has
38 significance with
39 respect to imparting
40 herbicidal activity to
41 dicamba compounds.
42 Thus, the solicitor
43 contends, one skilled in
44 the art would have been
45 motivated to uses, with

1 dicamba, substituted
2 ammonium salts made from
3 a known amine, such as
4 the amine disclosed by
5 Zorayan and Wideman, and
6 would have expected such
7 a salt to have
8 herbicidal activity.
9 Before the PTO may
10 combine the disclosures
11 of two or more prior art
12 references in order to
13 establish prima facie
14 obviousness, there must
15 be some suggestion for
16 doing so, found either
17 in the references
18 themselves or in the
19 knowledge generally
20 available to one of
21 ordinary skill in the
22 art." In re Fine, 837
23 F.2d 1071, 1074, 5
24 USPQ2d 1596, 1598-99
25 (Fed. Cir. 1988). We
26 see no such suggestion
27 in Zorayan, which is
28 directed to shampoo
29 additives, nor Wideman,
30 which teaches that the
31 amine used to make the
32 claimed compound is a
33 byproduct of the
34 production of
35 morpholine. Nor does
36 the board disclosure of
37 Richter fill the gap,
38 for the reasons
39 discussed above."[at
40 1943][Emphasis added]

41 And, in Arkie Lures, Inc. v. Gene Larew Tackle, Inc., 912 F.Supp.
42 422, 38 USPQ.2d 1300 (W.D.Ark. 1996), where the Court held:

43 "The existence of
44 separate elements of the

1 invention in the prior
2 art is insufficient to
3 establish obviousness,
4 absent some teaching or
5 suggestion in the prior
6 art to combine the
7 elements." [Emphasis
8 added]

9 And, in Gambro Lundia AB v. Baxter Healthcare Corporation, 110 F.3d
10 1573, 42 USPQ.2d 1378 (Fed. Cir. 1997), where the court held:

11 "Without a suggestion or
12 teaching to combine, a
13 case of obviousness is
14 deficient." [Emphasis
15 added]

16 The Courts further require, however, that even if the prior art may
17 be modified as suggested by the Examiner, the modification is not made
18 obvious unless the prior art suggests the desirability of the
19 modification, as was expressed in the 1992 Federal Circuit Court decision
20 in In re Fritch, 922, F.2d 1260, 23 USPQ.2d 1780, where the Court held:

21 "Mere fact that prior
22 art may be modified to
23 reflect features of
24 claimed invention does
25 not make modification,
26 and hence claimed
27 invention, obvious
28 unless desirability of
29 such modification is
30 suggested by prior art
31" [at 1780] [Emphasis
32 added]

33 "The mere fact that the
34 prior art may be
35 modified in the manner
36 suggested by the
37 Examiner does not make
38 the modification obvious
39 unless the prior art
40 s u g g e s t e d t h e

1 desirability of the
2 modification. In re
3 Gordon, 733 F.2d at 902,
4 221 USPQ at 1127."[at
5 1783][Emphasis added]

6 And further, the Fritch Court at 1783, held that the patent
7 applicant may attack the Examiner's prima facie determination as
8 improperly made out and tending to support a conclusion of nonobviousness:

9 "In proceedings before
10 the Patent and Trademark
11 Office, the Examiner
12 bears the burden of
13 establishing a prima
14 facie case of
15 obviousness based upon
16 the prior art...[The
17 Examiner] can satisfy
18 this burden only by
19 showing some objective
20 teaching in the prior
21 art or that knowledge
22 generally available to
23 one of ordinary skill in
24 the art would lead to
25 that individual to
26 combine the relevant
27 teachings of the
28 references. The patent
29 applicant may then
30 attack the Examiner's
31 prima facie
32 determination as
33 improperly made out, or
34 the applicant may
35 present objective
36 evidence tending to
37 support a conclusion of
38 nonobviousness."
39 [Emphasis added]

40 In this same regard, the Examiner's attention is respectfully drawn
41 to the decisions in Heidelberger Druckmaschinen AG v. Hantscho Commercial
42 Products, Inc., 21 F.3d 1068, 30 USPQ.2d 1377; In re Fine, 837 F.2d 1071,

1 5 USPQ.2d 1596 (Fed. Cir. 1988); In re Keller, 642 F.2d 413, 208 USPQ 871
2 (CCPA 1981); and In re Merck & Co., Inc., 800 F.2d 1091, 231 USPQ 375
3 (Fed. Cir. 1986).

4 In properly applying the Graham v. John Deere Co. test in light of,
5 inter alia, In re Jones, and In re Fritch discussed supra, the Examiner
6 must conduct a rigorous examination and analysis of the prior art. It
7 would appear that the Examiner has not done so.

8 Neither Brendel et al., Bell et al., nor for that matter any of the
9 references cited by the Examiner, make any motivating suggestion that,
10 inter alia the system of Brendel et al. can be modified to have its
11 outgoing address replaced by the outgoing address of Bell et al., as
12 suggested by the Examiner, let alone the desirability for such a
13 modification.

14 The Examiner has merely combined elements in a piecemeal manner in
15 light of applicant's disclosure to show obviousness by using applicant's
16 own specification as though it were prior art and in doing so has violated
17 the basic mandate inherent in 35 U.S.C. 103, as was decided in In re Kamm
18 and Young, 17 USPQ 298 ff, where the Court held:

19 "The rejection here runs
20 afoul of a basic mandate
21 inherent in section 103
22 - that a piecemeal
23 reconstruction of the
24 prior art patents in the
25 light of appellants'
26 disclosure shall not be
27 the basis for a holding
28 of obviousness."
29 [Emphasis added]

30 And, in In re Stephens, Wenzl, and Browne, 145 USPQ 656 (CCPA 1965),
31 where the Court reversed a rejection on a combination of references and
32 held:

33 "References may not be
34 c o m b i n e d
35 indiscriminately and

1 with guidance from
2 applicant's disclosure
3 to show that the claims
4 are unpatentable."[at
5 656][Emphasis added]

6 "In our consideration of
7 the record in light of
8 appellants' arguments,
9 we find nothing which
10 demonstrates that the
11 examiner and the board
12 erred in rejecting the
13 claims. While we agree
14 with appellants that
15 references may not be
16 c o m b i n e d
17 indiscriminately and
18 with guidance from
19 appellants' disclosure
20 to show that claims are
21 unpatentable, we think
22 the combination of
23 references her is proper
24 and adequately suggests
25 the structure appellants
26 have achieved."[at 657]
27 [Emphasis added]

28 And, in Panduit Corp. v. Burndy Corporation et al., 180 USPQ 498
29 (District Court, N.D. Illinois, E. Div.), where the Court held:

30 "Inquiry into the
31 patentability must be
32 directed toward subject
33 matter as a whole and
34 not to elements of a
35 combination and their
36 individual novelty;
37 combination which
38 results in a more
39 facile, economical, or
40 efficient unit, or which
41 provides results
42 unachieved by prior art
43 structures, cannot be

1 anticipated piecemeal by
2 showing that elements
3 are individually old."
4 [at 498][Emphasis added]

5 "The inquiry into the
6 patentability must be
7 directed toward the
8 subject matter as a
9 whole and not to the
10 elements of the claimed
11 combination and their
12 individual novelty, and
13 therefore a patented
14 combination which
15 results in a more
16 facile, economical or
17 efficient unit, or which
18 provides results
19 unachieved by prior art
20 structures, cannot be
21 anticipated piecemeal by
22 showing that the various
23 elements of the
24 invention are
25 individually old.

26 The difference between
27 the subject matter set
28 forth in the Re. 26,492
29 patent and the subject
30 matter of the cited
31 prior art references as
32 a whole would not have
33 been obvious at the time
34 the invention was made
35 to a person of ordinary
36 skill in the art to
37 which such subject
38 matter pertains, under
39 35 U.S.C. 103.[at 505]
40 [Emphasis added]

41 And, in Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH, 139 F.3d
42 877, 45 USPQ.2d 1977 (Fed. Cir. 1998), where the Court held:

1 "Federal district
2 court's formulation of
3 problem confronting
4 inventors of needles for
5 automatic knitting
6 machine presumes their
7 solution to problem,
8 namely modification of
9 "stem segment" of
10 needles; defining
11 problem in terms of its
12 solution reveals
13 improper hindsight in
14 selection of prior art
15 relevant to obviousness,
16 resulted in district
17 court adopting overly
18 narrow view of scope of
19 prior art, and infected
20 district court's
21 determinations about
22 content of prior art."
23 [at 1978][Emphasis
24 added]

25 "To ascertain the scope
26 of the prior art, a
27 court examines "the
28 field of the inventor's
29 endeavor," Shatterproof
30 Glass Corp. v. Libbey-
31 Owens Ford Co., 758 F.2d
32 613, 620, 225 USPQ 634,
33 628 (Fed. Cir. 1985),
34 and "the particular
35 problem with which the
36 inventor was involved,"
37 Stratoflex, Inc. v.
38 Aerquip Corp., 713 F.2d
39 1530, 1535, 218 USPQ
40 871, 876 (Fed. Cir.
41 1983) (quoting In re
42 Wood 599 F.2d 1032,
43 1036, 202 USPQ 171, 174
44 (CCPA 1979)), at the
45 "time the invention was

1 made," see 35 U.S.C. §
2 103(a). The district
3 court defined the
4 problem as "designing
5 the stem segment of a
6 knitting needle...[to]
7 minimize[] needle head
8 breakage and thus
9 maximize[] the operating
10 speed of an industrial
11 knitting machine."
12 (emphasis added). The
13 '053 patent, on the
14 other hand, describes
15 the inventor's problem
16 as "providing [knitting
17 needles] with a means
18 which avoids head
19 breakages or lets
20 [breakages] start to an
21 extent worth mentioning
22 only at higher knitting
23 speeds." '053 patent,
24 col. 1, lines 48-51.
25 The district court's
26 formulation of the
27 problem confronting the
28 '053 inventors presumes
29 the solution to the
30 problem - modification
31 of the stem segment.
32 defining the problem in
33 terms of its solution
34 reveals improper
35 hindsight in the
36 selection of the prior
37 art relevant to
38 obviousness. See, e.g.
39 In re Antle, 444 F.2d
40 1168, 1171-72, 170 USPQ
41 285, 287-88 (CCPA 1971)
42 (warning against
43 selection of prior art
44 with hindsight). By
45 importing the ultimate
46 solution into the

1 problem facing the
2 inventors, the district
3 court adopted an overly
4 narrow view of the scope
5 of the prior art. It
6 also infected the
7 district court's
8 determinations about the
9 content of the prior
10 art."[at 1981][Emphasis
11 added]

12 And, in In re Rouffet, 149 F.3d 1350, 47 USPQ.2d 1453 (Fed. Cir.
13 1998), where the Court reversed the Board's decision in which the level of
14 skill in the art being high was not sufficient to supply motivation:

15 "Three possible sources
16 for motivation to
17 combine prior art
18 references in manner
19 that would render
20 claimed invention
21 obvious are nature of
22 problem to be solved,
23 teachings of prior art,
24 and knowledge of persons
25 of ordinary skill in
26 art; high level of skill
27 in field of art cannot
28 be relied upon to
29 provide necessary
30 motivation absent
31 explanation of what
32 specific understanding
33 or technical principle,
34 within knowledge one of
35 ordinary skill in art,
36 would have suggested
37 combination, since if
38 such rote invocation
39 could suffice to supply
40 motivation to combine,
41 more sophisticated
42 scientific fields would
43 rarely, if ever,
44 experience patentable

1 technical advance."[at
2 1453][Emphasis added]
3 "Claimed low orbit
4 satellite communication
5 system for mobile
6 terminals is not prima
7 facie obvious over
8 combination of two prior
9 art references, even
10 though person possessing
11 high level of skill
12 characteristic of this
13 field would know to
14 account for differences
15 between claimed
16 invention and prior art
17 combination, since high
18 level of skill in art,
19 without more, cannot
20 supply required
21 motivation to combine
22 references, and does not
23 overcome absence of any
24 actual suggestion to
25 combine; obviousness
26 rejection will not be
27 upheld, even where skill
28 in art is high, absent
29 specific identification
30 of principle, known to
31 one of ordinary skill,
32 that suggests claimed
33 combination."[at 1454]
34 [Emphasis added]

35 Furthermore, pursuant to 37 CFR 1.111(c), claims 1 and 4 define the
36 following advantageous distinctive features, that distinguish over, and
37 avoid, the prior art:

38 a) "...said main server...
39 requesting over the
40 Internet that said at
41 least one participant
42 server send the
43 requested information

1 over the Internet back
2 to the client..."[claim
3 1][Emphasis added];

4 b) "...if said at least one
5 participant server does
6 not have the requested
7 information, the
8 requested information is
9 downloaded from said
10 main server to said at
11 least one participant
12 server..."[claim 1]
13 [Emphasis added];

14 c) "requesting over the
15 Internet, by said main
16 server acting like an
17 orchestra leader, that
18 said at least one
19 nearest participant
20 server send the
21 requested information
22 over the Internet back
23 to the client..."[claim
24 4][Emphasis added]; and

25 d) "downloading the
26 requested information
27 from said main server to
28 said at least one
29 nearest participant
30 server..."[claim 4]
31 [Emphasis added].

32 It was decided in In re Miller, 169 USPQ 597 (CCPA 1971) that each
33 and every limitation, inter alia those discussed supra, must be met in
34 determining patentability:

35 "All words in a claim
36 must be considered in
37 judging the
38 patentability of that
39 claim against the prior
40 art."[at 600][Emphasis
41 added]

1 In this same regard, the Examiner's attention is respectfully
2 directed to the decisions in In re Fuetterer, 138 USPQ 217 (CCPA 1963);
3 and In re Ludke and Sloan, 169 USPQ 563 (CCPA 1971).

4 When the Internet system of the present invention is designed in
5 accordance with the advantageous distinctive features of claims 1 and 4
6 discussed supra, inter alia:

- 7 1. The at least one participant server can be located anywhere in the
8 world regardless of where in the world the main server is located
9 ipso facto "...said main server... requesting over the Internet that
10 said at least one participant server send the requested information
11 over the Internet back to the client..."[claim 1][Emphasis added]
12 and "requesting over the Internet, by said main server acting like
13 an orchestra leader, that said at least one nearest participant
14 server send the requested information over the Internet back to the
15 client..."[claim 4][Emphasis added], as opposed to the main server
16 communicating with the at least one participant server over a
17 discrete and/or distinct and/or dedicated connection.
- 18 2. Costly multicasting [the at least one participant server is
19 relatively easy and inexpensive to add as compared to clustering
20 more servers to the main server] is not required if the at least one
21 participant server does not contain the requested information ipso
22 facto "...if said at least one participant server does not have the
23 requested information, the requested information is downloaded from
24 said main server to said at least one participant server..."[claim
25 1][Emphasis added] and "downloading the requested information from
26 said main server to said at least one nearest participant server..."
27 [claim 4][Emphasis added].

28 Even though the advantageous features of the present invention
29 discussed supra may not have been disclosed and discussed specifically in
30 the specification of the patent application as it was originally filed,
31 they still must be relied upon as evidence of patentability, as was

1 decided in In re Chu, 66 F.3d 292, 36 USPQ.2d 1089 (Fed. Cir. 1995), where
2 the Court held:

3 "Board of Patent Appeals
4 and Interferences erred,
5 in upholding obviousness
6 rejection of applicant's
7 claims, by concluding
8 that claims' disclosure
9 was matter of "design
10 choice," and that the
11 applicant's evidence and
12 arguments to contrary
13 are not present in
14 specification and are
15 therefore unpersuasive,
16 since board is required
17 to consider totality of
18 record and is not free
19 to disregard evidence
20 and arguments presented
21 by applicants, and since
22 there is no support for
23 proposition that
24 evidence and/or
25 arguments traversing 35
26 USC 103 rejection must
27 be contained within
28 specification, given
29 that obviousness is
30 determined by totality
31 of record including, in
32 some instances most
33 significantly, evidence
34 and arguments proffered
35 during give-and-take of
36 ex parte patent
37 prosecution."[at 1090]
38 [Emphasis added]

39 "Because the Board was
40 required to consider the
41 totality of the record,
42 the Board was not free
43 to disregard the
44 evidence and arguments

1 presented by Chu in
2 response to the
3 obviousness rejection.
4 Additionally, the Board
5 erred in apparently
6 requiring Chu's evidence
7 and arguments responsive
8 to the obviousness
9 rejection to be within
10 his specification in
11 order to be considered.
12 To require Chu to
13 include evidence and
14 arguments in the
15 specification regarding
16 whether placement of the
17 SCR catalyst in the bag
18 retainer was a matter of
19 "design choice" would be
20 to require patent
21 applicants to divine the
22 rejections the PTO will
23 proffer when patent
24 applications are filed."
25 [at 1094][Emphasis
26 added]

27 "We have found no cases
28 supporting the position
29 that a patent
30 applicant's evidence
31 and/or arguments
32 traversing a § 103
33 rejection must be
34 contained within the
35 specification. There is
36 no logical support for
37 such a proposition as
38 well, given that
39 obviousness is
40 determined by the
41 totality of the record
42 including, in some
43 instances, most
44 significantly, the
45 evidence and arguments

1 proffered during the
2 give-and-take of ex
3 parte patent
4 prosecution."[at 1095]
5 [Emphasis added]

6 And, even though the present invention may be considered simple and
7 accomplishes only a small but genuine improvement by some is not
8 sufficient reason to deny it patent protection, as was decided in Schnell
9 et al. v. The Albright-Nell Company et al., 146 USPQ 322 (Court of
10 Appeals, Seventh Circuit 1965), where the Court held:

11 "Device seems simple and
12 obvious in light of
13 patentee's teaching, but
14 it evidently was not
15 obvious at time of
16 invention; those working
17 in the field did not
18 accomplish patentee's
19 results; that fact
20 supports conclusion that
21 patentee achieved
22 patentable invention."
23 [at 322][Emphasis added]

24 "This now seems simple
25 and obvious in the light
26 of the Schnell teaching,
27 but is was evidently not
28 at all obvious at the
29 time of the invention.
30 Those working in the
31 field did not accomplish
32 Schnell's results. That
33 fact supports the
34 conclusion that Schnell
35 achieved patentable
36 inventions. Pyle Nat.
37 Co. v. Lewin, 7 Cir.,
38 1937, 92 F.2d 628, 630,
39 35 USPQ 40, 42."[at 324]
40 [Emphasis added]

1 The Board of Appeals expressed the same concept when it held in Ex
2 parte Grasenick and Gessner, 158 USPQ 624 (Patent Office Board of Appeals
3 1967), that:

4 "Improvement over prior
5 art, even though it be
6 simple or involves only
7 a reversing of certain
8 parts, is patentable
9 unless prior art shows
10 that improvement is
11 obvious." [at 624]
12 [Emphasis added]

13 "This rejection is in
14 error. An improvement
15 over the prior art, even
16 though it be simple or
17 involves only a
18 reversing of certain
19 parts, is patentable
20 unless the prior art
21 shows the improvement to
22 be obvious. The
23 examiner has neither
24 cited evidence
25 establishing the
26 obviousness of
27 appellant's modification
28 of the prior art nor
29 demonstrated that the
30 improved results claimed
31 by appellants are not
32 available from their
33 construction." [at 624]
34 [Emphasis added]

35 Attention is also respectfully directed in this regard to the
36 decisions in Mercantile National Bank of Chicago et al v. Quest, Inc. et
37 al. DC., N.D. Indiana, 166 USPQ 517, In re Shelby, 136 USPQ 220, and In re
38 Irani and Moedritzer, 166 USPQ 24, which all indicate that simplicity does
39 not operate as a bar to patentability if the invention was unobvious at
40 the time it was made.

1 Turning now to the references, and with regard to advantageous
2 distinctive feature a) of amended claim 1 discussed supra, contrary to the
3 Examiner's statement made at page 4, paragraph 11, lines 8-11 of the last
4 Office Action, Brendel et al. does not teach "...said main server...
5 requesting over the Internet that said at least one participant server
6 send the requested information over the Internet back to the client..."
7 [claim 1][Emphasis added] or "requesting over the Internet, by said main
8 server acting like an orchestra leader, that said at least one nearest
9 participant server send the requested information over the Internet back
10 to the client..."[claim 4][Emphasis added], but rather teaches that the
11 load balancer 70 (relied upon by the Examiner at page 4, paragraph 11,
12 line 3 of the last Office Action as the main server of the present
13 invention) communicates with a server 52 (relied upon by the Examiner at
14 page 4, paragraph 11, line 6 of the last Office Action as the at least one
15 participant server of the present invention) over the discrete and/or
16 distinct and/or dedicated connection 120 that is independent of Internet
17 66, as shown in figure 8 of Brendel et al. (relied upon by the Examiner).

18 With this arrangement of Brendel et al., the server 52 cannot be
19 located anywhere in the world regardless of where in the world the load
20 balancer 70 is located ipso facto the load balancer 70 communicates with
21 the server 52 over the discrete and/or distinct and/or dedicated
22 connection 120.

23 With regard to advantageous distinctive feature b) of amended claim
24 1 discussed supra, contrary to the Examiner's statement made at page 4,
25 paragraph 11, line 6 to page 5, line 2 of the last Office Action, Brendel
26 et al. does not teach "...if said at least one participant server does not
27 have the requested information, the requested information is downloaded
28 from said main server to said at least one participant server..."[claim 1]
29 [Emphasis added] or "downloading the requested information from said main
30 server to said at least one nearest participant server..."[claim 4]
31 [Emphasis added], but rather teaches that the information downloaded from

1 the load balancer 70 to the server 52 is not the requested information but
2 rather is the browser's stored ACK packet, as shown in the middle of
3 figure 11A of Brendel et al. where it is disclosed that ACK(0) is
4 forwarded from the load balancer 70 to the server connected to the client
5 and as discussed at col. 12, lines 50-52 of Brendel et al. (relied upon by
6 the Examiner at page 5, lines 2-5 of the last Office Action), where it is
7 disclosed:

8 "The load balancer then
9 sends the browsers
10 stored ACK packet to the
11 assigned server...."
12 [Emphasis added]

13 And, wherein the ACK(0) packet is an acknowledgment packet by the
14 browser 10 to the load balancer 70, as discussed at col. 12, lines 17-19
15 of Brendel et al., where it is disclosed:

16 "The load balancer
17 replies with a SYN/ACK
18 packet to the browser,
19 and the browser replies
20 with an acknowledgment
21 packet. ACK(0)."
22 [Emphasis added]

23 With this arrangement of Brendel et al., costly multicasting would
24 be required if the servers other than that containing the load balancer
25 did not contain the requested information.

26 Brendel et al. teaches away from the present invention, a fact that
27 must be considered in determining obviousness, as was decided in General
28 Tire and Rubber Co. v. Firestone Tire and Rubber Co., 174 USPQ at 445,
29 where the Court held:

30 "In assessing the prior
31 art, the Court must have
32 regard for all of the
33 signposts contained in
34 it. It must consider
35 the passages and
36 references which point

1 away from the invention
2 as well as those said to
3 point toward it..."
4 [Emphasis added]"

5 To properly apply the decisional law of General Tire and Rubber Co.
6 v. Firestone Tire and Rubber Co., one must first define what is considered
7 "teaching away." The definition of "teaching away" was succinctly
8 expressed in United States v. Adams, 383 U.S. 39, 52, 148 USPQ 479,484, 15
9 L.Ed.2D 572, 86 S.Ct. 708 (1966); and W.L. Gore & Assoc., v. Garlock,
10 Inc., 721 F.2d 1540, 1550-51, 220 USPQ 303, 311 (Fed. Cir. 1983), cert.
11 denied, 469 U.S. 851 (1984), where the Court held:

12 "a reference teaches
13 away if it suggests that
14 the line of development
15 flowing from the
16 reference's disclosure
17 is unlikely to be
18 productive of the result
19 sought by the
20 applicant." [Emphasis
21 added]

22 The connection between the load balancer and the server of Brendel
23 et al. being through a discrete and/or distinct and/or dedicated
24 connection that is independent of the Internet results in the servers not
25 being able to be located anywhere in the world regardless of where in the
26 world the load balancer is located and is therefore non-productive in
27 producing the connection between the main server and the at least one
28 participant server of the present invention being through the Internet
29 which results in the at least one participant server being able to be
30 located anywhere in the world regardless of where in the world the main
31 server is located. Therefore, pursuant to W.L. Gore & Assoc., v. Garlock,
32 Inc. discussed supra, Brendel et al. teach away from the present
33 invention.

34 The information downloaded from the load balancer to the server of
35 Brendel et al. being the browser's stored ACK packet would require costly

1 multicasting if the servers other than that containing the load balancer
2 did not contain the requested information and would therefore be non-
3 productive in producing the information downloaded from the main server to
4 the at least one participant server of the present invention that is the
5 requested information and therefore would not require costly multicasting
6 if the at least one participant server does not contain the requested
7 information. Therefore, pursuant to W.L. Gore & Assoc., v. Garlock, Inc.
8 discussed supra, Brendel et al. again teach away from the present
9 invention.

10 Brendel et al. would therefore lead a reader in a path divergent
11 from the path that was taken by applicant and therefore "teaches away"
12 from the present invention and can not be used to create a prima facie
13 case of obviousness, as was decided in In re Gurley, 27 F.3d 551, 31, 31
14 USPQ.2d at 1130 (Fed. Cir. 1994), where the Court held:

15 "a reference may be said
16 to teach away when a
17 person of ordinary
18 skill, upon reading the
19 reference would be led
20 in a direction divergent
21 from the path that was
22 taken by the applicant
23 ...a reference that
24 "teaches away" can not
25 create a prima facie
26 case of obviousness."
27 [Emphasis added]

28 The signposts of Brendel et al. that teach away from the present
29 invention must be considered in creating a holding of obviousness, as
30 required by General Tire and Rubber Co. v. Firestone Tire and Rubber Co.,
31 United States v. Adams, W.L. Gore & Assoc., v. Garlock, Inc., and In re
32 Gurley discussed supra which when analyzed will clearly indicate that the
33 Examiner's combination is improper.

34 Regarding dependent claims 2, 3, 5, and 6, applicant respectfully
35 submits that it is well settled that these claims must be considered in

1 determining patentability as including the limitations of the claims from
2 which they depend, as was supported in In re Schutte, 244 F.2d 323, 327
3 (CCPA 1957), where the Court held:

4 "a dependent claim must
5 be read as including the
6 limitations of the claim
7 from which it depends."
8 [Emphasis added]

9 Applicant has provided clear and convincing evidence that neither
10 Brendel et al., Bell et al., nor for that matter any of the references
11 cited by the Examiner, accomplish applicant's result of providing an
12 efficient Internet system that, inter alia:

- 13 1. Enables the at least one participant server to be located anywhere
14 in the world regardless of where in the world the main server is
15 located.
- 16 2. Eliminates a need for costly multicasting if the at least one
17 participant server does not contain the requested information.

18 Therefore a holding of obviousness cannot be made out, as was
19 decided by the Board of Appeals in Ex parte Tanaka, Marushima and
20 Takahashi, 174 USPQ 38, where the Board held:

21 "Claims are not rejected
22 on the ground that it
23 would be obvious to one
24 of ordinary skill in the
25 art if the prior art
26 devices do not
27 accomplish applicant's
28 result." [Emphasis added]

29 And, in In re Wright, 122 USPQ 522 (1959), where the Court held:

30 "...the mere aggregation
31 of old elements that did
32 not perform a different
33 function is not a
34 patentable invention,
35 but that a novel
36 combination of old
37 elements which cooperate

1 with each other to
2 produce a new or useful
3 result or a substantial
4 increase in efficiency
5 is patentable."[Emphasis
6 added]

7 And, further in the en banc decision in In re Dillon, 919 F.2d 688,
8 692 (Fed. Cir. 1990), where the Court held:

9 "...a prima facie case
10 of obviousness requires
11 that the prior art
12 suggest the claimed
13 compositions' properties
14 and the problem the
15 applicant attempts to
16 solve."[Emphasis added]

17 In this same regard, the Examiner's attention is respectfully
18 directed to the decisions in In re Halleck, 164 USPQ 647 (CCPA 1970); and
19 Kockum Industries, Inc. v. Salem Equipment, Inc., 175 USPQ 81 (9th Cir.
20 1972).

21 In light of, inter alia In re Deuel, Richardson-Vicks Inc. v. The
22 Upjohn Co., the Graham v. John Deere Co. test in light of, inter alia MPEP
23 706.02, In re Jones, Arkie Lures, Inc. v. Gene Larew Tackle, Inc., Gambro
24 Lundia AB v. Baxter Healthcare Corporation, In re Fritch, Heidelberger
25 Druckmaschinen AG v. Hantscho Commercial Products, Inc., In re Fine, In re
26 Keller, and In re Merck & Co., Inc., In re Kamm and Young, In re Stephens,
27 Wenzl, and Browne, Panduit Corp. v. Burndy Corporation et al., Monarch
28 Knitting Mach. Corp. v. Sulzer Morat GmbH, In re Rouffet, In re Miller, In
29 re Fuetterer, In re Ludke and Sloan, In re Chu, Schnell et al. v. The
30 Allbright-Nell Company et al., Ex parte Grasenick and Gessner, Mercantile
31 National Bank of Chicago et al v. Quest, Inc. et al., In re Shelby, In re
32 Irani and Moedritzer, General Tire and Rubber Co. v. Firestone Tire and
33 Rubber Co., United States v. Adams, W.L. Gore & Assoc., v. Garlock, Inc.,
34 In re Gurley, In re Schutte, Ex parte Tanaka, Marushima and Takahashi, In
35 re Wright, In re Dillon, In re Halleck, and Kockum Industries, Inc. v.

1 Salem Equipment, Inc. discussed supra, pursuant to In re Fritch discussed
2 supra applicant attacks the Examiner's prima facie determination as being
3 improperly made out and tending to support a conclusion of nonobviousness.

4 In summation, since neither Brendel et al., Bell et al., nor for
5 that matter any of the references cited by the Examiner, taken singularly
6 teaches "...said main server...requesting over the Internet that said at
7 least one participant server send the requested information over the
8 Internet back to the client..."[claim 1][Emphasis added], "...if said at
9 least one participant server does not have the requested information, the
10 requested information is downloaded from said main server to said at least
11 one participant server..."[claim 1][Emphasis added], "requesting over the
12 Internet, by said main server acting like an orchestra leader, that said
13 at least one nearest participant server send the requested information
14 over the Internet back to the client..."[claim 4][Emphasis added], and
15 "downloading the requested information from said main server to said at
16 least one nearest participant server..."[claim 4][Emphasis added], any
17 hypothetical combination thereof would not lead to applicant's invention.

18 In view of the arguments presented supra, applicant respectfully
19 submits that the Examiner's grounds for the rejection of claims 3, 5, and
20 6 under 35 U.S.C. 102(a) as being anticipated by Brendel et al., the
21 Examiner's grounds for the rejection of claim 2 under 35 U.S.C. 8 102(e)
22 as being anticipated by Bell et al., and the Examiner's grounds for the
23 rejection of claims 1 and 4 under 35 U.S.C. 103(a) as being unpatentable
24 over Brendel et al. in view of Bell et al. are no longer tenable and
25 therefore respectfully requests that the rejections be withdrawn.

26 The prior art cited, but not relied upon, has been duly noted.

27 In view of the above, it is submitted that the claims are in
28 condition for allowance. Reconsideration and withdrawal of the rejections
29 are requested. Allowance of claims 1-6 at an early date is earnestly
30 solicited.